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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,601	02/28/2002	Akihiro Kuroda	3094-39	7638
29540	7590	06/06/2005	EXAMINER	
PITNEY HARDIN LLP 7 TIMES SQUARE NEW YORK, NY 10036-7311			YU, GINA C	
		ART UNIT		PAPER NUMBER
		1617		

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/070,601	KURODA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Gina C. Yu	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-21,23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-21,23 and 25-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Receipt is acknowledged of supplemental amendment filed under 37 C.F.R. § 1.11(b), on March 10, 2005. The finality of Office action dated July 14, 2004 is hereby withdrawn in view of applicants' claim amendment and new search. Claims 1, 3-21, 23, and 25-28 are pending. Claim rejections made under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated July 14, 2004 is hereby withdrawn in view of claim amendment in view of the applicants' claim amendment. New rejections are made.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 1. Claims 1, 3- 9, 12, 15, 19-21, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 5061481) in view of Sakuta (US 4970252) and Abamba (Poucher's Perfumes, Cosmetics and Soaps).**

Suzuki teaches a composition comprising methylphenylpolysiloxane (nonvolatile low viscosity silicone oils, of instant claims 3, 6, and 7) and dimethylpolysiloxane, both having viscosity of 10 cs; acryl-silicone graft copolymer and partially cross-linked organopolysiloxane polymer (instant claims 8 and 12). See Example 11. The example also contains a composition comprising titanium dioxide in Example 12. See instant claims 20 and 24. The reference also teaches that the invention is a composition comprising volatile silicone oils such as octamethylcyclotetrasiloxane and decamethylcyclopentasiloxane. See col. 11, lines 3 – 8; instant claims 3-5. The reference teaches that any silicone oils having a viscosity below 50 cs can be used as

the low viscosity silicone oil. See col. 5, lines 31 – 43. The reference further teaches that perfluoroalkyl(methyl)acrylates can be also used to form the acryl-silicone graft copolymer of instant claims. See, col. 3, line 58 – col. 4, line 17. See instant claim 19. The reference teaches eyeliner composition comprising 1,3-buтиylene glycol, which has hydroxyl groups. See instant claim 1.

While the reference teaches that any liquid silicone oil can be used the reference and particularly mentions octa- and deca-methylcyclopentasiloxanes, dimethylpolysiloxane, and methylphenylpolysiloxane, the reference fails to particularly mention the organopolysiloxane of formula (I) of instant claims 1 and 24 (methlytris(trimethylsiloxy)silane). See col. 5, lines 31 – 42. The reference teaches that 2 or more of low viscosity silicone oils can be used in combination if necessary. See col. 6, lines 44 – 48.

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is comparable substitute for other low viscosity silicone oil also well known in the art. Methlytris(trimethylsiloxy)silane is said to have 1 mm<sup>2</sup> /s (cSt). See col. 4, lines 16 – 35. See Example 6.

Abamba teaches to use polyols and fatty alcohols as moisturizers in skin care compositions. See p. 368-369.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Suzuki by adding methyltris(trimethylsiloxy)silane as motivated by Sakuta because the latter teaches that the silicone oil is a functional equivalent of the volatile silicone oils taught in the Suzuki reference, such as octamethylcyclotetrasiloxane or decamethylcyclopentasiloxane. The skilled artisan would have had a reasonable expectation of successfully producing a similar cosmetic composition because Suzuki teaches that any silicone oils having a viscosity below 50 cs can be used.

Alternatively, it is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of two conventional low viscosity silicone oils well known in cosmetic art. It would follow that the recited claims define prima facie obvious subject matter.

Further modifying the composition by incorporating polyols or fatty alcohols as taught by Abamba would have been also obvious, as the reference teaches that these compounds are conventionally used as moisturizers.

**2. Claims 1, 8, 9, 12, 20, 21, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Mellul (US 5496544) in view of Sakuta (US 4970252) and Abamba (Poucher's Cosmetics, Perfumes and Soaps).**

Mellul teaches cosmetic composition comprising a silicone gum, a silicone wax, and a silicone resin, and low-viscosity silicone oil. See col. 3, line 1 – col. 5, line 21; Example 4. The reference teaches using silicone polysiloxane gums having MW of 200K-1000K, and particularly mentions to use polymethylsiloxanes. See col. 3, lines 31 – 49. See instant claims 8 and 9. Example 4 also contains mica and talc. The reference in col. 5, lines 55 – 58 also teaches iron oxides, which are well known UV screening agents. See instant claims 20, 21, and 24. The reference also teaches trimethylsiloxysilicate in the compositions. See Examples; instant claims 8 and 12.

Mellul fails to teach the silicone oil of instant claim 1, formula (I).

Sakuta ('252), as discussed above, teaches methyltris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

Abamba teaches to use polyols and fatty alcohols as moisturizers in skin care compositions. See p. 368-369.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Mellul by substituting the low viscosity silicone oil with methyltris(trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition. It would have been also obvious to further modify the composition by incorporating polyols or fatty alcohols as taught by Abamba would have been also obvious, as the reference teaches that these compounds are conventionally used as moisturizers.

3. **Claims 1, 8, 10, 11, 13, 14, 20, 21, 23, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Nakamura et al. (US 5853711) in view of Sakuta (US 4970252).**

Nakamura teaches a water-in-oil emulsion cosmetic composition comprising a mixture of organopolysiloxane elastomer spherical powder and a hydrophobic silica powder; and an oil phase containing at least 30 % by weight, based upon the total oil phase, of silicone oil. See abstract; Examples. See instant claims 8 and 10.

Dimethylsilylated silica powders, AEROSIL R972 (polyalkylsilsesquioxane), and trimethylsilylated silica powders, AEROSIL R813, are disclosed in col. 3, lines 12 – 21. See instant claims 11 and 13. The reference also teaches silicone oils including methylpolysiloxane, methylphenylpolysiloxane, cyclic dimethylpolysiloxane (octamethylcyclotetrasiloxane, etc) in the oily phase. See col. 3, lines 33-48. The reference also teaches using glycerol (which has 3 hydroxyl groups) and thickeners. See col. 6, lines 12 – 14. See instant claims 1 and 28. The reference also teaches using polyether silicone surfactant. See col. 4, lines 13 – 26; claims 13, 14, 26, and 27.

Nakamura fails to teach methlytris(trimethylsiloxy)silane of claim 1, formula (I).

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is compatible substitute for other low

viscosity silicone oil also well known in the art. Methlytris(trimethylsiloxy)silane is said to have 1 mm<sup>2</sup> /s (cSt). See col. 4, lines 16 – 35. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Nakamura by substituting the disclosed silicone oils with methlytris (trimethylsiloxy)silane as motivated by Sakuta ('252) because the latter teaches the functional equivalency of the organopolysiloxane with the silicone oils that Nakamura teaches. The skilled artisan would have had a reasonable expectation of successfully producing a similar cosmetic composition.

**4. Claims 1 and 15-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over in view of Sakuta (US 5236986) ('986) in view of Sakuta (US 4970252) ('252).**

Sakuta ('986) teaches a cosmetic composition comprising a mixture of a crosslinked silicon polymer and a low viscosity silicone oil, the mixture being kneaded under shearing conditions sufficient to cause the silicone polymer to be swollen with the silicone oil. See col. 2, lines 61 – 66. See instant claim 18. The silicone oil preferably has a viscosity at 25 °C of not higher than 100 centistokes, and the Examples use dimethylpolysiloxane. The reference teaches that the polymers are obtained by addition polymerization of at least one organohydrogenpolysiloxanes and either polyoxyalkylene or organopolysiloxane disclosed in col. 2, lines 25 – 31, and col. 3, lines 42 – 68. Example 1 teaches that organopolysiloxane having at least two alkenyl groups per molecule is reacted with the product in Synthetic Example 1, which contains Si-H bond.

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See instant claim 16. Application example 1 contains 1,3-butylene glycol, which has two hydroxyl groups. See instant claim 1.

The reference fails to teach the compound of instant claim 1, formula (I). Sakuta ('252) teaches that methyltris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is a compatible substitute for and a functional equivalent of other low viscosity silicone oil also well known in the art.

Methyltris(trimethylsiloxy)silane is said to have 1 mm<sup>2</sup> /s (cSt). See col. 4, lines 16 – 35.

See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of '986 by substituting the low viscosity silicone oil with methyltris (trimethylsiloxy) silane as motivated by '252 because of the expectation of successfully producing a similar cosmetic composition.

**5. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over in view of Suzuki, Sakuta, and Abamba as applied to claims 1, 3- 9, 12, 15,19-21, and 28 as above, and further in view of Starch (US 6121383).**

Suzuki teaches that basic purpose of cosmetic composition is to impart moisturizing properties and that humectants are used for this reason. See col. 1, lines 22 – 29. The reference at col. 16, lines 56 – 68 also teaches to add humectant to the

invention. The application of the invention includes solid foundation, liquid foundation, O/W emulsion, stick eyeshadow, and cream. See Examples.

Suzuki and Sakuta fail to teach the non-elastomer solid polysiloxanes of instant claim 25.

Starch teaches a method of thickening water-in-silicone emulsion which is useful in formulating cosmetics, including liquid foundations, antiperspirants, and skin moisturizers. See col. 1, lines 21 – 28. The reference teaches to add the latex in water phase rather than in silicone phase to delay swelling until the contact of the two phases to facilitate processing. See col. 1, lines 34 – 42. The reference teaches using cyclic siloxanes such as octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane for the silicone phase. The reference teaches that trimethylsiloxysilicate, an MQ resin, is blended in film-forming organic polysiloxanes to make a silicone emollient. See col. 5, lines 10 – 38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the silicone emollient comprising trimethylsiloxysilicate as motivated by Starch, because 1) all references are directed to cosmetic compositions; 2) Suzuki teaches using emollients; 3) and the skilled artisan would have had expected to successfully produce a cosmetic composition with emolliency.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-21, 23, and 25-28 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



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